Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ROBERT F. SHAW

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Appeal No. 2003-0760
Application No. 05/730,221

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ON BRIEF

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Before URYNOWICZ, THOMAS, and GARRIS, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

Decision on Appeal

This appeal is from the final rejection of claims 9-30 and 32-37.

The invention pertains to a cutting instrument. Claim 9 is illustrative and reads as follows:

> 9. An instrument for cutting, the instrument comprising:
>
> blade-shaped means of said instrument that has an edge which forms the cutting edge thereof; including
>
> means capable of being heated to elevate the temperature of the blade-shaped means in the region of the cutting edge, said means capable of being heated being in the region of said edge and having a physical parameter which varies as a function of temperature to increase power dissipation in response to selective cooling of regions along said edge for maintaining the temperature of said edge within said selected temperature range.

The references relied upon by the examiner are:

Meyer	958,753	May 24, 1910
Mitchell et al. (Mitchell)	2,863,036	Dec. 02, 1958
Marcoux	3,414,705	Dec. 03, 1968
Hirschhorn	3,502,080	Mar. 24, 1970

Claims 9, 10, 13-16, 19, 20 and 23-26 stand rejected under 35 U.S.C. § 103 as unpatentable over Mitchell in view of Marcoux.

Claims 11, 12, 17, 18, 21 and 22 stand rejected under 35 U.S.C. § 103 as unpatentable over Mitchell in view of Marcoux and Hirschhorn.

Claims 27-30 and 32-37 stand rejected under 35 U.S.C. § 103 as being unpatentable over Meyer in view of Marcoux.

The respective positions of the examiner and appellant with regard to the propriety of these rejections are set forth in the

examiner's answer (Paper No. 21) and the appellant's brief and reply brief (Paper Nos. 20 and 22, respectively).

Appellant's Invention

The invention is adequately described on pages 1 and 2 of appellant's brief under the heading "Statement of the Invention".

The Rejection under 35 U.S.C. § 103 of Claims 9, 10, 13-16, 19, 20 and 23-26

The examiner contends that motivation to substitute the electric heating system of Marcoux, which utilizes material having a positive temperature coefficient, for the electric heating system of Mitchell, which utilizes heater and a rheostat, is to avoid the disadvantages of a thermostat. According to the examiner, these disadvantages are temperature fluctuation and a relatively short life of the device.

Appellant submits that there is no suggestion from the references which justifies a combination thereof. Appellant argues that the examiner's position presupposes that the prior art suggested a need for or desirability of a cutting blade maintained at a constant elevated temperature and that nowhere in the references can such a suggestion be found.

We will not sustain this rejection. We do not find the motivation set forth by the examiner for combining the teachings of Mitchell and Marcoux as persuasive. This is because Mitchell heats his butchering knife with a circuit controlled by a rheostat, not a thermostat. Mitchell's rheostat does not automatically adjust the circuit in order to maintain a knife at constant temperature, as would a thermostat. Accordingly, the teachings in Marcoux as to the disadvantages of a thermostatically controlled circuit would not have applied to Mitchell's circuit controlled by a rheostat. Otherwise, appellant is correct that there is no suggestion from the prior art that it would have been in any way desirable to modify the heated butchering knife of Mitchell so as to maintain the knife at a constant elevated temperature for its disclosed purpose of trimming animal corpus in a cold room.

The Rejection under 35 U.S.C. § 103
of Claims 11, 12, 17, 18, 21 and 22

We found, above, that motivation for combining the teachings of Mitchell and Marcoux was not established. Whereas Hirschhorn is not relied upon in the rejection for establishing such motivation, but is relied upon to establish that the use of

ceramic in a surgical blade was known in the art, we will not sustain this rejection.

The Rejection under 35 U.S.C. § 103(a) of Claims 27-30 and 32-37

We will not sustain this rejection.

In the first place, Meyer discloses a cauterizing wire D. Wire D is not disclosed as forming a cutting edge. Accordingly, combining the teachings of Meyer and Marcoux does not result in a method utilizing a cutting edge.

Furthermore, assuming for purpose of argumentation that wire D of Meyer forms a cutting edge, the examiner did not establish that Meyer or Marcoux, or the combination thereof, suggests for any reason the desirability of increasing power dissipation in selected regions along a cutting edge to maintain the temperature of the cutting edge substantially within a selected operating range. The problem addressed by appellant is not recognized by the prior art. That problem is to prevent significant increased bleeding in fleshy areas of a corpus which tend to cool adjacent portions of a cutting edge. Appellant accomplishes this by increasing power dissipation in those adjacent portions of the cutting edge so as to maintain the temperature of the edge

substantially within a selected operating range. The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

REVERSED

STANLEY M. URYNOWICZ, JR. Administrative Patent Judge	)	
JAMES D. THOMAS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BRADLEY R. GARRIS Administrative Patent Judge	)	

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